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| 10/777,429 | 02/12/2004 | Richard W. Cheston | RPS920030177US1 | 4339 |
| 56687 7590 05/28/2009 Driggs, Hogg, Daugherty & Del Zoppo Co., L.P.A. 38500 CHARDON ROAD DEPT. LEN WILLOUGHBY HILLS, OH 44094 | | | EXAMINER ERB, NATHAN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/777,429 | Applicant(s) CHESTON ET AL. | |
| | Examiner NATHAN ERB | Art Unit 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant's response to Office action was received on February 10, 2009.
3. In response to Applicant's amendment of the claims, the claim objection from the previous Office action is hereby withdrawn.
4. In response to Applicant's amendment of the claims, the corresponding claim rejections have been correspondingly amended below in this Office action.
5. Examiner believes that the amendments to the prior art rejections below in this Office action render Applicant's arguments to be no longer applicable.
6. If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. Therefore, all official notice and "well-known" statements from the previous Office action which were not adequately traversed are hereby taken to be admitted prior art.

Claim Rejections - 35 USC § 103

7. Claims 1, 3-4, 6-14, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al., U.S. Patent Application Publication No. US 2005/0137973 A1, in view of Hensley, U.S. Patent Application Publication No. US

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2004/0133790 A1, in further view of Liccione et al., U.S. Patent Application Publication

No. US 2004/0158766 A1.

As per Claims 1 and 8, Hoffman et al. discloses:

- a method (title of reference);
- charging a first price for a computer system (paragraphs [0040] and [0049]);
- tracking the execution by the computer system of the at least one chargeable technology (paragraphs [0013]-[0014]);
 - wherein said tracking includes: gathering information relative to the execution (paragraphs [0013]-[0014]);
 - storing the information (paragraphs [0013]-[0014]; paragraph [0067]);
 - charging an additional price for each execution of the at least one chargeable technology by the computer system (paragraphs [0013]-[0014]);
 - selecting execution of the chargeable technology on the client computing system (paragraphs [0013]-[0014]);
 - executing said selected chargeable technology (paragraphs [0013]-[0014]);
 - collecting data relating to said execution on said client computing system (paragraphs [0013]-[0014]);
 - storing said collected data (paragraphs [0013]-[0014]; paragraph [0067]).

Hoffman et al. fails to disclose wherein information (or data) is stored in secure storage (or a protected storage area on said system) that is protected from tampering. Hensley discloses wherein information (or data) is stored in secure storage (or a protected storage area on said system) that is protected from tampering (paragraph [0010]; paragraph [0015]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that information (or data) is stored in secure storage (or a protected storage area on said system) that is protected from tampering, as disclosed by Hensley, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. fails to disclose detecting at least one system problem in the computer system that is addressable by at least one chargeable technology; executing (or selecting execution) in the computer system the at least one chargeable technology for each occurrence of the detected at least one system problem; charging on a per usage basis (for each execution of the chargeable technology). Liccione et al. discloses detecting at least one system problem in the computer system that is addressable by at least one chargeable technology (paragraph [0059]); executing (or selecting execution) in the computer system the at least one chargeable technology for each occurrence of the detected at least one system problem (paragraph [0016]; paragraph [0026]; paragraph [0059]; paragraph [0096]); charging on a per usage basis (for each execution of the chargeable technology) (paragraph [0026]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. such that it detects at least one system problem in the computer system that is addressable by at least one chargeable technology; executes (or selects execution) in the computer system the at least one chargeable technology for each occurrence of the detected at least one system problem; and charges on a per usage basis (for each execution of the chargeable technology), as disclosed by Liccione et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Claims 3 and 9, Hoffman et al. further discloses said information comprising: a date and time of the execution; an identity of the chargeable technology executed; and unique identifying information associated with the computer system (paragraphs [0013]-[0014]; p. 5, Table 1).

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As per Claims 4 and 10, Hoffman et al. and Hensley fail to disclose encrypting the collected data before storing the collected data. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 3 such that it encrypts the collected data before storing the collected data, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that encrypting data helps ensure privacy.

As per Claim 6, Hoffman et al. further discloses wherein said computer system comprises at least two computer systems delivered by a system provider to at least two users within a group (paragraph [0071]; "users" indicates multiplicity of customers).

As per Claim 7, Hoffman et al. further discloses wherein tracking the execution of the at least one chargeable technology comprises tracking said execution on all systems within the group (paragraphs [0013]-[0014]; paragraph [0071]; "users" indicates multiplicity of customers). Hoffman et al. and Hensley fail to disclose charging one price to the group for all executions of the at least one chargeable technology by the users within the group. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 6 such that it charges one price to the group for all executions of the at least one chargeable technology by the users within the group, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that it is sometimes more convenient to group users under a single bill.

As per Claim 11, Hoffman et al. further discloses gathering said collected data from the protected storage area and forwarding said collected data to a predetermined central location on the network in response to the client computing system being connected to the network (paragraph [0067]).

As per Claim 12, Hoffman et al. further discloses wherein the determining, gathering and forwarding steps are performed without the intervention or knowledge of a user of said system (paragraph [0067]).

As per Claim 13, Hoffman et al. further discloses wherein the selecting execution step comprises initiation by a user of the system (paragraphs [0013]-[0014]).

As per Claim 14, Hoffman et al. and Hensley fail to disclose wherein the selecting execution step comprises an automatic selection by the system based on an occurrence of a pre-determined event, without the intervention or knowledge of a user of the system. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 8 such that the selecting execution step comprises an automatic selection by the system based on an occurrence of a pre-determined event, without the intervention or knowledge of a user of the system, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that automatic triggering of computer resources when needed is convenient.

As per Claim 38, Hoffman et al. further discloses wherein the at least one chargeable technology is the computer system (paragraphs [0013]-[0014]).

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As per Claim 39, Hoffman et al. further discloses wherein the at least one chargeable technology is hardware of the computer system (paragraphs [0013]-[0014]).

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Hensley in further view of Liccione et al. in further view of Dresden, U.S. Patent Application Publication No. US 2005/0021440 A1.

As per Claim 2, Hoffman et al. and Hensley fail to disclose wherein the first price is lower than a break-even price for a provider. Dresden discloses wherein the first price is lower than a break-even price for a provider (paragraph [0009]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 1 such that the first price is lower than a break-even price for a provider, as disclosed by Dresden. Motivation is provided by Dresden in that selling below cost may be used to gain market share (paragraph [0009]).

9. Claims 5 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Hensley in further view of Liccione et al. in further view of Abrams et al., U.S. Patent Application Publication No. US 2002/0166117 A1.

As per Claim 5, Hoffman et al. further discloses wherein charging an additional price comprises: gathering the stored data relating to use of the chargeable technology; creating a technology usage report indicating the use of each chargeable technology; creating an invoice representing charges for the at least one chargeable technology; sending the report and the invoice to a user of the computer system (paragraphs [0013]-[0014]; paragraph [0054]). Hoffman et al. and Hensley fail to disclose wherein billing is done on a per-use basis. Abrams et al. discloses wherein billing is done on a per-use basis (paragraph [0138]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 3 such that billing is done on a per-use basis, as disclosed by Abrams et al. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that per-use may be a strategically desirable way to bill for a business's service.

As per Claim 29, Hoffman et al. discloses:

- a method (paragraphs [0013]-[0014]);
- receiving data in a client system relating to execution by a user on said system of at least one chargeable technology (paragraphs [0013]-[0014]);
- storing said data in a manner retrievable according to the user (paragraphs [0013]-[0014]; paragraph [0067]);
- periodically retrieving said data according to user and creating a technology usage report for each user indicating usage of each chargeable technology by each user (paragraphs [0013]-[0014]; paragraph [0067]; p. 5, Table 1).

Hoffman et al. fails to disclose wherein the data storage is tamper proof. Hensley discloses wherein the data storage is tamper proof (paragraph [0010]; paragraph [0015]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that the data storage is tamper proof, as disclosed by Hensley, since the claimed invention is merely a combination of old elements, and in the

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combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. fails to disclose executing at least one chargeable technology when at least one event is recognized needing the at least one chargeable technology, wherein the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology. Liccione et al. discloses executing at least one chargeable technology when at least one event is recognized needing the at least one chargeable technology, wherein the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology (paragraph [0016]; paragraph [0026]; paragraph [0059]; paragraph [0096]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. such that it executes at least one chargeable technology when at least one event is recognized needing the at least one chargeable technology, wherein the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology, as disclosed by Liccione et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. and Hensley fail to disclose wherein billing is done on a per-use basis. Abrams et al. discloses wherein billing is done on a per-use basis (paragraph [0138]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified above in this rejection such that billing is done on a per-use basis, as disclosed by Abrams et al. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that per-use may be a strategically desirable way to bill for a business's service.

Hoffman et al., Hensley, and Abrams et al. fail to disclose generating the technology usage report at the server. However, it was well-known to one of ordinary skill in the art at the time of applicants' invention that functions in a client/server system can typically be performed at either the client or the server. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified above in this rejection such that it generates the technology usage report at the server; in doing so, it would be performing the function at the server, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that a server may have more processing power than a client.

As per Claim 30, Hoffman et al. further discloses configuring the client system with at least one chargeable technology; and configuring the client system with a capability to track and report data relating to the execution by a user of the system of the at least one chargeable technology (paragraphs [0013]-[0014]).

As per Claim 31, Hoffman et al., Hensley, and Abrams et al. fail to disclose wherein an invoice representing charges is generated at the client. However, it was well-known to one of ordinary skill in the art at the time of applicants' invention that functions in a client/server system can typically be performed at either the client or the server. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 29 such that an invoice representing charges is generated at the client; in doing so, it would be performing the function at the client, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that performing functions at a client may help relieve processing burden on a server.

10. Claims 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hoffman et al. in view of Hensley in further view of Proudler et al., U.S. Patent No.

7,302,698 B1, in further view of PR Newswire, "Terra Lycos and Network Associates(R)

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Team Up to Provide Online Security Protection for Consumers," New York, February 4, 2004, p. 1, in further view of Liccione et al.

As per Claim 15, Hoffman et al. discloses:

- a method (title of reference);
- selecting execution of a chargeable technology on said system (paragraphs [0013]-[0014]);
- executing said selected chargeable technology (paragraphs [0013]-[0014]);
- collecting data relating to said execution on said computer system (paragraphs [0013]-[0014]);
- storing said collected data (paragraphs [0013]-[0014]; paragraph [0067]).

Hoffman et al. fails to disclose recognizing in a computer system at least one event indicating a need for execution by the computer system of at least one chargeable technology. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention (this is typical when a user of a home computer initiates a virus cleaner program). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. such that a user recognizes in a computer system at least one event indicating a need for execution by the computer system of at least one chargeable technology, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that it is sometimes necessary to notice computer problems in order to correct them.

Hoffman et al. fails to disclose wherein data is stored in a protected storage area on said system. Hensley discloses data is stored in a protected storage area on said system (paragraph [0010]; paragraph [0015]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that data is stored in a protected storage area on said system, as disclosed by Hensley, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. and Hensley fail to disclose entering an alternate operating mode stored in the BIOS of the system from a primary operating mode by initiating execution of an alternate operating system; executing a function while in the alternate operating system; and returning control of the system to the primary operating system for normal operation. Proudler et al. discloses entering an alternate operating mode stored in the BIOS of the system from a primary operating mode by initiating execution of an alternate operating system; executing a function while in the alternate operating system; and returning control of the system to the primary operating system for normal operation (column 3, line 30, through column 6, line 26; column 12, line 65, through column 13, line 16; column 13, line 29, through column 14, line 19; column 16, line 46, through column 17, line 51). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that it enters an alternate operating mode stored in the BIOS of the system from a primary operating mode by initiating execution of an alternate operating system; executes a function while in the alternate operating system; and returns control of the system to the primary operating system for normal operation, as disclosed by Proudler et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

RESPONSE TO OFFICIAL NOTICE CHALLENGE: With respect to the prior art rejection of claim 15, Applicants dispute Examiner's "well-known" statement by stating that simply the fact that a user executes a virus cleaner program in response to some recognized problem does not mean that the virus program is necessarily a "chargeable technology." In response, Examiner counterargues that it is not necessary for the purposes of the rejection that a virus cleaner must ALWAYS be a chargeable

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technology; rather, it is sufficient for the purposes of the rejection that a virus program is sometimes a chargeable technology. In support of Examiner's "well-known" statement, Examiner presents PR Newswire, "Terra Lycos and Network Associates(R) Team Up to Provide Online Security Protection for Consumers," New York, February 4, 2004, p. 1, which demonstrates that some anti-virus software was indeed a chargeable technology. For example, Section A of PR Newswire discusses how the McAfee anti-virus software was being offered on a monthly subscription basis. Therefore, the user would be being charged for ongoing use of the software and such an anti-virus program was an example of a chargeable technology at the time. Therefore, Applicants' arguments are not persuasive with respect to this issue.

Hoffman et al. fails to disclose wherein the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology; executing said selected chargeable technology for each occurrence of the recognized at least one event. Liccione et al. discloses wherein the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology (paragraph [0026]); executing said selected chargeable technology for each occurrence of the recognized at least one event (paragraph [0016]; paragraph [0026]; paragraph [0059]; paragraph [0096]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. such that the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology; and the invention executes said selected chargeable technology for each occurrence of the recognized at least one event, as disclosed by Liccione et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Claim 16, Hoffman et al. fails to disclose wherein the selecting execution step comprises a selection by a user of the system of a chargeable technology to execute from a menu or list of available chargeable technologies presented to said user. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 15 such that the selecting execution step comprises a selection by a user of the system of a chargeable technology to execute from a menu or list of available chargeable technologies presented to said user, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that menus are a convenient way for a user to interface with a computer system.

As per Claim 17, Hoffman et al. fails to disclose wherein the selecting execution step comprises an automatic selection by the system of a chargeable technology to execute based on the type of the event. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 15 such that the selecting execution step comprises an automatic selection by the system of a chargeable technology to execute based on the type of the event, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that automated troubleshooters are convenient for users who may not be able to correct a problem on their own.

As per Claim 18, Hoffman et al. fails to disclose encrypting and digitally signing the data prior to storing the data. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 15 such that it encrypts and digitally signs the data prior to storing the data, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known

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to one of ordinary skill in the art at the time of applicants' invention that encrypting and digitally signing data helps ensure privacy.

As per Claim 19, Hoffman et al. fails to disclose wherein the stored data is protected from tampering. Hensley further discloses wherein the stored data is protected from tampering (paragraph [0010]; paragraph [0015]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that the stored data is protected from tampering, as disclosed by Hensley, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Claim 20, Hoffman et al. fails to disclose wherein said alternate operating system is provided on the system in a manner which is hidden from a user of the system and protected from tampering. Hensley further discloses wherein said alternate operating system is provided on the system in a manner which is hidden from a user of the system and protected from tampering (abstract; paragraphs [0001]-[0010]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 19 such that said alternate operating system is provided on the system in a manner which is hidden from a user of the system and protected from tampering, as disclosed by Hensley. Motivation is provided by Hensley in that such an alternate operating system can be useful in helping to recover a computer system from a virus attack (abstract; paragraphs [0001]-[0010]).

As per Claim 21, Hoffman et al. further discloses gathering said stored data and forwarding said data to a predetermined central location on the network in response to determining the system is connected to the network (paragraph [0067]).

As per Claim 22, Hoffman et al. further discloses wherein the entire said process is performed without the intervention or knowledge of a user of the system (paragraph [0067]).

11. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Hensley in further view of Proudler et al in further view of Liccione et al.

As per Claim 23, Hoffman et al. discloses:

- a method (title of reference);
- receiving at the central location data representing at least one execution by a remote system of at least one chargeable technology (paragraphs [0013]-[0014]; paragraph [0067]);
- storing said data in said central location (paragraphs [0013]-[0014]; paragraph [0067]).

Hoffman et al. fails to disclose wherein the execution of computing functions is distributed across a network. However, Examiner hereby takes Official Notice that this element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (for example, paid access to online remote computer services was well-known). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that the execution of computing functions is distributed across a network, as disclosed by Official Notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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Hoffman et al. fails to disclose wherein data is stored in a protected area, wherein the protected area protects stored data from tampering. Hensley discloses wherein data is stored in a protected area, wherein the protected area protects stored data from tampering (paragraph [0010]; paragraph [0015]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that data is stored in a protected area, wherein the protected area protects stored data from tampering, as disclosed by Hensley, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. and Hensley fail to disclose executing an alternate operating mode in response to a selection in a primary operating mode. Proudler et al. discloses executing an alternate operating mode in response to a selection in a primary operating mode (column 3, line 30, through column 6, line 26; column 12, line 65, through column 13, line 16; column 13, line 29, through column 14, line 19; column 16, line 46, through column 17, line 51). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that it executes an alternate operating mode in response to a selection in a primary operating mode, as disclosed by Proudler et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al., Hensley, and Proudler et al. fail to disclose wherein the selection of the execution of a computer program and the execution of the computer program occur in response to recognizing at least one event indicating a need for execution of at least one chargeable technology. However, Examiner hereby takes Official Notice that this element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (this is typical when a user of a home computer initiates a virus cleaner program). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that the selection of the execution of a computer program and the execution of the computer program occur in response to recognizing at least one event indicating a need for execution of at least one chargeable technology, as disclosed by Official Notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. fails to disclose wherein the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology. Liccione et al. discloses wherein the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology (paragraph [0026]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. such that the at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology, as disclosed by Liccione et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Claim 24, Hoffman et al. fails to disclose decrypting said data prior to storing said data. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. such that it decrypts said data prior to storing said data, as was well-known to one of ordinary skill in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that it is generally necessary to first decrypt data so that it may be used.

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As per Claim 25, Hoffman et al. further discloses wherein said data comprises: a date and time of the execution; an identity of the chargeable technology executed; and unique identifying information associated with the remote system (paragraphs [0013]-[0014]; p. 5, Table 1).

12. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Hensley in further view of Proudler et al. in further view of Liccione et al. in further view of Abrams et al.

As per Claim 26, Hoffman et al. further discloses in response to the central location having connectivity to the remote system: gathering the stored data corresponding to said remote system; creating an invoice representing charges for said execution of said at least one chargeable technology; and forwarding said invoice to the remote system (paragraphs [0013]-[0014]; paragraph [0054]). Hoffman et al., Hensley, and Proudler et al. fail to disclose wherein billing is done on a per-use basis. Abrams et al. discloses wherein billing is done on a per-use basis (paragraph [0138]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 25 such that billing is done on a per-use basis, as disclosed by Abrams et al. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that per-use may be a strategically desirable way to bill for a business's service.

As per Claim 27, Hoffman et al. further discloses wherein said remote system comprises at least two remote systems associated with at least two users within at least one group (paragraph [0071]; "users" indicates multiplicity of customers).

As per Claim 28, Hoffman et al., Hensley, and Proudler et al. fail to disclose conducting the billing process on a group basis. Abrams et al. further discloses conducting the billing process on a group basis (paragraph [0068]; paragraph [0078]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that it conducts the billing process on a group basis, as disclosed by Abrams et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

13. Claims 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Proudler et al. in further view of Liccione et al.

As per Claim 32, Hoffman et al. discloses:

- a computer system (paragraphs [0013]-[0014]);
- at least one central processing unit (CPU) (paragraphs [0013]-[0014]);
- a memory operatively connected to the CPU (paragraph [0098]);
- a non-volatile storage operatively connected to the CPU and holding at least a primary operating system for execution on said CPU and effective to execute controlling the operation of the system (paragraphs [0013]-[0014]; paragraph [0098]; operable computers have operating systems);
- a communication interface operatively connected to said CPU for interfacing said system with a network (paragraphs [0013]-[0014]);
- at least one chargeable technology accessible for execution on said CPU (paragraphs [0013]-[0014]);

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- a chargeable-technology-usage-tracking component accessible for execution on said CPU for tracking the execution by the system of the at least one chargeable technology (paragraphs [0013]-[0014]).

Hoffman et al. fails to disclose a bootable device operatively connected to the system and holding at least an alternate operating system for execution on said CPU and effective when executing for controlling the operation of the system. Proudler et al. discloses a bootable device operatively connected to the system and holding at least an alternate operating system for execution on said CPU and effective when executing for controlling the operation of the system (column 3, line 30, through column 6, line 26; column 12, line 65, through column 13, line 16; column 13, line 29, through column 14, line 19; column 16, line 46, through column 17, line 51). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that it includes a bootable device operatively connected to the system and holding at least an alternate operating system for execution on said CPU and effective when executing for controlling the operation of the system, as disclosed by Proudler et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. fails to disclose charging for at least one chargeable technology on a per usage basis for each execution of the at least one chargeable technology. Liccione et al. discloses charging for at least one chargeable technology on a per usage basis for each execution of the at least one chargeable technology (paragraph [0026]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. such that it charges for at least one chargeable technology on a per usage basis for each execution of the at least one chargeable technology, as disclosed by Liccione et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Claim 35, Hoffman et al. discloses:

- a central-location computer system (paragraphs [0013]-[0014]; paragraph [0067]);
- at least one central processing unit (CPU) (paragraphs [0013]-[0014]; paragraph [0067]; paragraph [0098]);
- a memory operatively connected to the CPU (paragraphs [0013]-[0014]; paragraph [0067]; paragraph [0098]);
- a non-volatile storage operatively connected to the CPU and holding at least a primary operating system for execution on said CPU which is effective to execute controlling the operation of the system (paragraphs [0013]-[0014]; paragraph [0067]; paragraph [0098]; operable computers have operating systems);
- a communication interface operatively connected to said CPU for interfacing said system with a network (paragraphs [0013]-[0014]);
- a chargeable-technology-data-receiving component for receiving from remote systems data indicative of execution on said remote systems of the at least one chargeable technology (paragraphs [0013]-[0014]; paragraph [0067]);
- a technology-usage-data-reporting-and-billing component for periodically sending to the remote systems a usage report detailing the use by the remote systems of the at least one chargeable technology (paragraphs [0013]-[0014]; paragraph [0054]).

Hoffman et al. fails to disclose a BIOS of the system that holds at least an alternate operating system for execution on said CPU in response to the selection of the execution of a computer program while in the primary operating system. Proudler et al. discloses a BIOS of the system that holds at least an alternate operating system for execution on said CPU in response to the selection of the execution of a computer program while in the primary operating system (column 3, line 30, through column 6, line 26; column 12, line 65, through column 13, line 16; column 13, line 29, through column 14, line 19; column 16, line 46, through column 17, line 51). It would have been obvious to one of ordinary skill in the art to

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modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that it includes a BIOS of the system that holds at least an alternate operating system for execution on said CPU in response to the selection of the execution of a computer program while in the primary operating system, as disclosed by Proudler et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. and Proudler et al. fail to disclose wherein the selection of the execution of a computer program occurs in response to recognizing at least one event indicating a need for execution of at least one chargeable technology. However, Examiner hereby takes Official Notice that this element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (this is typical when a user of a home computer initiates a virus cleaner program). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. (including any previous modifications above in this rejection or in the rejection of a claim [or claims] from which this claim depends [or these claims depend]) such that the selection of the execution of a computer program occurs in response to recognizing at least one event indicating a need for execution of at least one chargeable technology, as disclosed by Official Notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Hoffman et al. fails to disclose wherein said at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology. Liccione et al. discloses wherein said at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology (paragraph [0026]). It would have been obvious to one of ordinary skill in the art to modify the invention of Hoffman et al. such that said at least one chargeable technology is charged for on a per usage basis for each execution of the at least one chargeable technology, as disclosed by Liccione et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

14. Claims 33-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Proudler et al. in further view of Liccione et al. in further view of Hensley.

As per Claim 33, Hoffman et al. and Proudler et al. fail to disclose wherein the alternate operating system is located in a tamper proof, protected and hidden area and wherein said alternate operating system executes on said CPU to perform functions. Hensley discloses wherein the alternate operating system is located in a tamper proof, protected and hidden area and wherein said alternate operating system executes on said CPU to perform functions (abstract; paragraphs [0001]-[0010]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 32 such that the alternate operating system is located in a tamper proof, protected and hidden area and wherein said alternate operating system executes on said CPU to perform functions, as disclosed by Hensley. Motivation is provided by Hensley in that such a configuration may help to recover a computer system with system problems (abstract; paragraphs [0001]-[0010]).

As per Claim 34, Hoffman et al. further discloses storing data relating to the execution by the system of said at least one chargeable technology (paragraphs [0013]-[0014]; paragraph [0067]).

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Hoffman et al. and Proudler et al. fail to disclose a secure, hidden area of said non-volatile storage. Hensley discloses a secure, hidden area of said non-volatile storage (abstract; paragraphs [0001]-[0010]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 32 such that it includes a secure, hidden area of said non-volatile storage, as disclosed by Hensley. Motivation is provided by Hensley in that such an area can help safeguard data from computer viruses (abstract; paragraphs [0001]-[0010]).

As per Claim 36, Hoffman et al. further discloses storing the data received from the remote systems (paragraphs [0013]-[0014]; paragraph [0098]). Hoffman et al. and Proudler et al. fail to disclose a secure, hidden area of said non-volatile storage for use. Hensley discloses a secure, hidden area of said non-volatile storage for use (abstract; paragraphs [0001]-[0010]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. such that it includes a secure, hidden area of said non-volatile storage for use, as disclosed by Hensley. Motivation is provided by Hensley in that such an area can help safeguard data from computer viruses (abstract; paragraphs [0001]-[0010]).

15. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Proudler et al. in further view of Liccione et al. in further view of Hensley in further view of Abrams et al.

As per Claim 37, Hoffman et al. further discloses wherein said usage report comprises an invoice representing charges for the executions by the remote systems of the at least one chargeable technology (paragraphs [0013]-[0014]; paragraph [0054]). Hoffman et al., Proudler et al., and Hensley fail to disclose wherein billing is done on a per-use basis. Abrams et al. discloses wherein billing is done on a per-use basis (paragraph [0138]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hoffman et al. as modified in the rejection for claim 36 such that billing is done on a per-use basis, as disclosed by Abrams et al. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that per-use may be a strategically desirable way to bill for a business's service.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN ERB whose telephone number is (571) 272-7606. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NATHAN ERB
Examiner
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/John W Hayes/
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